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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,888	01/10/2002	Jonas L. Steinman	12000097-0005-002	6273

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EXAMINER	
DURAN, ARTHUR D	
ART UNIT	PAPER NUMBER
3622	
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01/12/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/043,888	STEINMAN ET AL.	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 December 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10,13,20,22,23 and 56-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10,13,20,22,23 and 56-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/8/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 10, 13, 20, 22, 23, 56, 57, 58 have been examined.

Response to Amendment

The Amendment filed on12/8/09 is sufficient to overcome the prior rejection. However, a new rejection has been made.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10, 13, 20, 22, 23, 56, 57, 58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Representative independent claim 10 has new features added on 12/8/09 stating “a magnified version of the small form”. However, the word “magnified” or any of the derivatives of “magnify" does not exist in the Applicant’s Specification. Applicant has support for a large version of the ad but not for “magnify” or any of its derivatives.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

> invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10, 13, 20, 22, 23, 56, 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dustin (6,496,857) in view of Mannik (20040122731).

Claims 10, 22, 23. Dustin discloses:

serving a first Web page to each of a plurality of users, the first Web page including a small form of an the advertisement (Figs. 2-2, 3-2, 4-2, 4-3; Abstract); and

serving a second Web page to each of the plurality of users, the second Web page including a large form of the advertisement wherein the large form of the advertisement (i) has dimensions larger than the small form and (ii) has similar shape and proportions as the small form (Figs. 2-3, 4-2, 4-3; Abstract; 7:59-8:5).

Dustin further discloses (iii) is a magnified version of the small form (Fig. 4-2, 4-3).

Dustin does not explicitly disclose that the ad is generated from a print advertisement.

However, Dustin discloses print catalogs or print ads (2:50-57). And, Applicant states that it is old and well known to place print ads from magazines also on websites (Applicant's Specification, Background of the Invention, [9] of PG Pub Version). Hence, it is obvious that a website ad can be generated from a print version of an ad. As an example of this, Mannik discloses that the website ad is generated from a print advertisement (Fig. 8; [143, 146]) and also small and large versions of an ad (Fig. 18a). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Dustin's a website ad can be generated from a print

version of an ad. One would have been motivated to do this in order to offer ads of better interest and exposure to users.

Claim 13. (Dustin further discloses the method of claim 10, further comprising:

providing an indication of an opportunity to view said large form of said advertisement to each user (7:1-20; 7:59-8:5); and

receiving an indication of willingness to view said large form of said advertisement from each user (7:1-20; 7:59-8:5).

Claim 20. Dustin discloses the above. Dustin does not explicitly disclose wherein said large form of said advertisement is scrolled on the second Web page. However, Dustin discloses scrolling to view ads (7:1-20) and that large size forms of ads can be presented (Fig. 2-3 and above citations). And, the MPEP 2144.04.IV.A states that changes in size are obvious. Hence, it is obvious that the large size of Dustin's ads can be increased even larger to warrant the scrolling capability of Dustin for viewing. One would be motivated to do this to present ads in a desired large size and with the necessary functionality for viewing.

Claim 56. Dustin further discloses wherein one or more a brand component, said small form of said advertisement, and said large form of said advertisement is served for a fixed period of time (7:1-20).

Alternatively, Dustin does not explicitly disclose wherein one or more a brand component, said small form of said advertisement, and said large form of said advertisement is served for a fixed period of time. However, Dustin discloses displaying ads for a period of time (7:1-20) and the Applicant states that it was obvious, old and

well known to display ads for a fixed period of time on a screen (Applicant's own Specification PG_Pub version at [7]). Hence, it is obvious that Dustin can display the ads for a fixed period of time. One would be motivated to do this to better display ads for a relevant period.

Claim 57. Dustin further discloses:

receiving an indication of a confirmation of a viewing of at least one of a brand component, said small form of said advertisement, and said large form of said advertisement (1:65-2:16; 7:1-20; 7:59-8:5); and

receiving an indication of a willingness to view at least one of said brand component, said small form of said advertisement, and said large form of said advertisement (7:1-20; 7:59-8:5; 1:65-2:16).

Note that the user selecting the thumbnail version of the ads acts as the user confirming viewing of the thumbnail/small form of the ad. Also, the selecting the thumbnail/small version of the ad in order to see the large/full form of the ads acts as a user indicating a willingness to see the large/full form of the ad.

Claims 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dustin (6,496,857) in view of Mannik (20040122731) in further view of [Cornell (20020083051) OR Kanno (20020194216)].

Claim 58: Dustin does not explicitly disclose wherein the first Web page including the small form of the advertisement is configured to be displayed for a period

of time, and after the period of time has elapsed, automatically serving the second Web page including the large form of the advertisement.

However, Dustin discloses displaying ads for a period of time (7:1-20) and the Applicant states that it was obvious, old and well known to display ads for a fixed period of time on a screen (Applicant's own Specification PG_Pub version at [7]). And, Dustin discloses enlarging the ad after the a period of time (8:30-35). And, as shown in the rejection of the claims above, Dustin discloses the small form of the ad on one page and the large form on second page. Hence, it is obvious that web pages can be automatically opened after periods of time. As an example of this, Cornell (claims 1, 4) OR Kanno ([98]) disclose serving a first webpage and then automatically serving a second webpage after a period of time. Hence, it is obvious that web pages can be automatically opened after periods of time. One would be motivated to do this to assist the user in bringing the user to items of interest or items desired to be displayed (Dustin, 8:30-35).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection above. Please see the addition of the Mannik reference above.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Zustak 20020087402 at [50, 64]; Mannik 20040122731 and Geilfuss 20020075332 disclose small versions of ads and large versions of ads. Mannik further discloses IER or interactive electronic representations of ads.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
Art Unit 3622

/Arthur Duran/
Primary Examiner, Art Unit 3622
1/7/2010